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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,441	10/17/2003	Samuel B. Osae	P-1086 C	1558
7590	04/12/2006		EXAMINER	
Scott R. Cox Lynch, Cox, Gilman & Mahan, P.S.C. 500 W. Jefferson Street, Suite 2100 Louisville, KY 40202			NUTTER, NATHAN M	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,441

Applicant(s)

OSAE ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 and 10-29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

In response to the amendment of 26 January 2006, the following is being placed into effect.

The objection to the disclosure is hereby expressly withdrawn.

The rejection of claims 7-9 are 13-16 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is hereby expressly withdrawn.

The rejection of claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,602,958, Briggs et al, is hereby expressly withdrawn.

The rejection of claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,852,801, Briggs et al, is hereby expressly withdrawn.

The rejection of claims 1-6, 10-16, 18-23 and 25 under 35 U.S.C. 102(e) as being anticipated by Cheng (U.S. Patent No. 6,291,593), is hereby expressly withdrawn.

The rejection of claims 1-6, 10-16, 18-23 and 25 under 35 U.S.C. 102(e) as being anticipated by Cheng (U.S. Patent No. 6,433,091), is hereby expressly withdrawn.

The rejection of claims 1-5, 7-10, 12, 14, 18, 19 and 23 under 35 U.S.C. 102(b) as being anticipated by Briggs (U.S. Patent 4,773,957), is hereby expressly withdrawn.

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The rejection of claims 1-5, 7, 8, 10, 12, 13, 18-20 and 23 under 35 U.S.C. 102(b) as being anticipated by Briggs et al (U.S. Patent 4,942,201), is hereby expressly withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The skilled artisan, without the undue burden of experimentation, cannot determine what is required by the recitation of "provides gel-like properties" in claims 27 and 29.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 10-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claims 27 and 29 of "gel-like properties" is not art-recognized. The term "like" renders the claim indefinite because the claim includes elements not

actually disclosed (those encompassed by "like"), thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).

The recitations in claims 28 and 29 of "diene-based" and "acrylic-based" renders the claims as indefinite. The metes and bounds of these claims cannot be determined since other undisclosed components may be employed.

Claims 1, 2, 3, 26, 27 and 29 recite the limitation "at least one thermoplastic...". The language of each of these claims is not indicative that there is more than one such polymer contemplated. There is insufficient antecedent basis for this limitation in each of the claims. Further, since the claims are deemed indefinite, all claims depending therefrom are rejected, as well.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7, 8, 10-13, 15-20, 23 and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Gosiewski et al (U.S. Patent 5,206,288).

The reference to Gosiewski et al (U.S. Patent 5,206,288) teaches the manufacture of an adhesive composition having a "thermoplastic or partially thermoplastic polymer or elastomer....an unsaturated polyester resin or vinyl ester resin, and....an alkyl acrylate or methacrylate monomer," as recited and claimed herein. Note column 5 (lines 1-13), the Abstract and column 1 (line 50) to column 2 (line 6) for the broad concept, including the compositional limitations as recited herein for claims 1-3. Note column 2 (lines 9-22) for the methacrylate ester monomers employed, as recited in claim 20. Note the inclusion thereof at (lines 23-26). The use of maleic acid is shown at column 2 (lines 27-32), as recited in claims 18 and 19. Note column 2 (lines 40-64) for the resins of claims 5, 7, 11 and 13. Note column 3 (lines 25-66) for the core-shell copolymers employed in claims 4 and 12. Other additives, as recited in claim 23, are shown at column 4 (lines 38-47). Finally, note the patent claims.

Claims 1-5, 7, 8, 10-13, 15, 16, 18-20, 23 and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Gosiewski et al (U.S. Patent 5,945,461).

The reference to Gosiewski et al (U.S. Patent 5,945,461) teaches the manufacture of an adhesive composition having a "thermoplastic or partially thermoplastic polymer or elastomer....an unsaturated polyester resin or vinyl ester resin, and....an alkyl acrylate or methacrylate monomer," as recited and claimed herein. Note column 2 (lines 56-63), column 3 (line 30) to column 4 (line 19) for the broad concept, including the compositional limitations as recited herein for claims 1-3, the methacrylate ester monomers employed, as recited in claim 10, and the organic acid,

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including acrylic acid and maleic acid, as recited in claims 18-20. Note column 3 (lines 42-67) for the resins of claims 5, 7, 8, 11, 13 and 17. Note column 4 (lines 32 et seq.) for the core-shell copolymers employed in claims 4 and 12. Mixtures of polymers, as recited in claim 9, are shown at column 4 (lines 21-31). Other additives, as recited in claim 23, are shown at column 5 (lines 29-65). Finally, note the patent claims.

Claims 1-3, 5, 7, 10, 13, 18-21, 23 and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Zalucha et al (US Patent 4,293,665).

The reference to Zalucha et al (US Patent 4,293,665) teaches the manufacture of an adhesive composition having a "thermoplastic or partially thermoplastic polymer or elastomer....an unsaturated polyester resin or vinyl ester resin, and....an alkyl acrylate or methacrylate monomer," as recited and claimed herein. Note the Abstract and column 5 (line 60) to column 6 (line 28) for the broad concept including the compositional limitations as recited herein for claims 1-3, 13 and 7 for the methacrylate ester monomers employed, as recited in claim 10, column 6 (line 5) for the use of an organic acid, including methacrylic acid, as recited in claims 18 and 19, and column 6 (lines 6-13) for the use of blends as recited in claim 5. Note column 7 (lines 18-23) for the use of maleic acid, as recited in claim 20. Note column 7 (lines 53 et seq.) for the use of a phosphate ester, as recited in claim 21.

Response to Arguments

Applicant's arguments filed 26 January 2006 have been fully considered but they are not persuasive.

With regard to the rejections of the claims over the references to Gosiewski et al (U.S. Patent 5,206,288) and Gosiewski et al (U.S. Patent 5,945,461), regretfully typographical errors, only in identification, of these two references were presented in the first Office Action. However, the rejection is being maintained and made final, herein. It is pointed out that applicants submitted Gosiewski et al (U.S. Patent 5,945,461) and, as such, would be fully responsible for its contents. Likewise, since the reference to Gosiewski et al (U.S. Patent 5,206,288) was cited in the Office Action, applicants are responsible for the contents of that reference, as well. It is easily apparent from reading the Office Action, and, indeed, applicants' Response, that a typographical error of identification had been made between the two references. Regardless, applicants are responsible to the rejections, if based only on their own interpretation of each of the two.

With regard to the rejection of the claims over Zalucha et al (US 4,293,665), it is irrelevant if a constituent in the patent is disclosed as being optional. The disclosure positively shows the inclusion, even if optional, of the polyester component. It is submitted that the inclusion of the alkyl acrylate monomers, as shown in the examples, would provide a degree of cross-linking of the elastomer component.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

8 April 2006